

REMARKS

In accordance with the foregoing, claims 1, 2, 6, 7, 15, 16, 20, 21, 29, 30, 34, and 35 have been amended. Claims 1-7, 9-21, 23-35, and 37-42 are pending and under consideration.

In the Office Action mailed December 18, 2008, claims 2 and 9-14 were objected to under 35 U.S.C. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim; claims 2, 6, 7, and 9-14 were rejected under 35 U.S.C. 112(2) as being indefinite; claims 15-21 and 23-38 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter; claims 1-5, 7, 9-19, 21, 23-33, 35, and 37-42 were rejected under 35 U.S.C. as being unpatentable over Johnson (U.S. Patent No. 5,664,109) and Official Notice; and claims 6, 20, and 34 were rejected under 35 U.S.C. 103 as being unpatentable over Johnson and Official Notice, and further in view of Amit (Federated Database Systems for Managing Distributed, Heterogeneous, and Autonomous Databases).

The foregoing objections and rejections are respectfully traversed.

Claims 16, 20, 21, 30, 34, and 35 are amended for clarification.

I. Objections to claims 2 and 9 - 14 and Rejections of claims 2, 6, 7, and 9 - 14 under 35 U.S.C. 112(2)

Claim 2 is amended, taking the Examiner's comments into consideration. Claims 6, 7, and 9-14 depend, either directly or indirectly, from claim 2.

Withdrawal of the foregoing objections and rejections is respectfully requested.

II. Rejections of claims 15 - 21 and 23 - 38 under 35 U.S.C. 101

Claim 15 is amended, taking the Examiner's comments into consideration. Claims 16 - 21 and 23 - 38 depend, either directly or indirectly, from claim 15.

It is respectfully submitted that Claims 15-21 and 23-38 recite statutory subject matter under 35 U.S.C. 101.

Withdrawal of the foregoing rejections is respectfully requested.

III. Rejections of claims 1-5, 7, 9-19, 21, 23-33, 35, and 37-42 under 35 U.S.C 103

Johnson discusses a method for extracting pre-defined data items from medical service records generated by health care providers.

However, Johnson does not discuss or suggest the features of the present invention as recited in claims 1-5, 7, 9-19, 21, 23-33, 35, and 37-42 of the present application.

More specifically, the Examiner's assertions in the Office Action that "portability enabling software", "master control file", "controlling and providing interoperability", "computer platforms operating on disparate operating systems", and "a personal computer" are taught by Johnson, are respectfully traversed.

(a) The Examiner relies upon Johnson, col. 2, at lines 13 - 26, as discussing "portability enabling software". However, Johnson, col. 2, at lines 13 - 26, discusses a "centralized record keeping system", rather than "portability enabling software" as in the present invention.

(b) The Examiner relies upon Johnson, Figure 7, label 702 ("master patient records"), as teaching "master control file" of the present invention. However, master patient records of Johnson does not correspond to the "master control file" of the present invention. Johnson, col. 13, lines 13 - 15 discusses "Records in tables 702 and 704...comprise "the MPI database, as indicated by dashed line 703". That is, Johnson, col. 13, lines 13-15, teaches away from the present invention rather than discussing a "master control file" as in the present invention.

(c) The Examiner relies upon Johnson, col. 2, at lines 27 - 37, as discussing "controlling and providing interoperability" and "computer platforms operating on disparate operating systems". However, Johnson, col. 2, at lines 27-37 discusses that providers are able to continue to use their preexisting information systems, including medical record numbers or patient identifiers".

It is respectfully submitted that "the computer platforms including a personal computer, a hand-held device, and a network" are recited in claims 1, 15, and 29 as features of the present invention, and that Johnson does not discuss or suggest "the computer platforms including a personal computer, a hand-held device, and a network".

The Examiner's assertions that the system of Johnson meets the limitations of the present invention because the system of Johnson is capable of interfacing with any device that

conforms to router network protocol are respectfully traversed. In accordance with MPEP 2144.03,

assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art

The Examiner is respectfully requested to support these assertions by citing a reference or by affidavit, or withdraw same.

Johnson does not discuss or suggest "a master control file controlling and providing interoperability of a medical records system between computer platforms operating on disparate operating systems, the master control file interfacing with a database of text and image data and medical records and with the disparate operating systems, and the computer platforms including a personal computer, a hand-held device, and a network" as recited in independent claims 1, 15, and 29 of the present application.

Claims 1, 15, and 29 of the present application each recites "the computer platforms including a personal computer, a hand-held device, and a network", which limitation is not discussed or suggested by Johnson. Therefore, it is respectfully submitted that Johnson does not discuss or suggest the foregoing features of the present invention, and does not teach that the Johnson system is capable of communicating with "a personal computer, a hand-held device, and a network" as recited in claims 1, 15, and 29 of the present application.

(d) The Examiner relies upon Johnson, Figure 1 label 118, communicating with a plurality of subscriber computer systems over a network, as discussing "a personal computer" of the present invention. However, label 118 of Figure 1 of Johnson refers to a router rather than a personal computer.

The Examiner admits that Johnson does not teach "hand-held device".

Official Notice

The Examiner asserts in the Office Action that "Official Notice is taken that laptop computers and palmtop computers are old and well established in the art of network computing".

The Examiner's assertions of Official Notice that laptop computers and palmtop computers are old and well established in the art of networking are respectfully traversed. The Examiner's assertions of Official Notice are not properly officially noticed and not properly based upon common knowledge. The Examiner is respectfully requested to support the assertion of Official Notice by citing a reference or by affidavit or withdraw same.

In accordance with MPEP 2144.03:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

More specifically, the Examiner has not provided any reasoning to support the Examiner's assertions that "laptop computers and palmtop computers are old and well established in the art of network computing", particularly taking into account the filing date and priority dates of the subject application.

The Examiner's assertions that "At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of the Official Notice within the embodiment of Johnson with the motivation of providing physicians with wireless computing platforms for convenience" are respectfully traversed.

It is respectfully submitted that the Examiner is improperly relying upon hindsight in these assertions. Moreover, the Examiner's assertions of Official Notice are respectfully traversed, as discussed above.

Moreover, MPEP 2141.02 requires that the claimed invention "as a whole" must be considered. Johnson identifies the problem of "centralizing and sharing medical records" (col. 1, lines 51 and 52) and discusses that a "centralized record keeping system receives record documents from one of a plurality of independent service providers" as Johnson's invention (col. 2, at lines 13-15). Johnson, Fig. 1, illustrates "a centralized, computer-based system 110 for receiving, storing and processing records" which includes "at least one network of server

computer 112 organized as a local area network for serving a plurality of subscriber client systems 114" (col. 4, at lines 41-49), and Johnson, col. 4, at lines 50 and 51, discusses that "Client systems 114 can be standalone computers or networks of computers".

Moreover, Johnson does not identify or address providing wireless platforms for the convenience of physicians.

Thus, the claimed invention as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made.

Further, in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396, (U.S. Supreme Court 2007), the Supreme Court stated,

"Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977,988 [78 USPQ2d 1329] (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")."

As the Examiner admits that Johnson does not a "hand-held device", Applicant respectfully submits that the Office Action does not articulate a reason for combining the references cited to support the legal conclusion of obviousness and to reject the claims.

It is also respectfully asserted that the Examiner has applied impermissible hindsight in this assertion in accordance with MPEP 2141.02:

"The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. "

It is respectfully submitted that Johnson does not discuss or suggest the foregoing features of the present invention as recited in claims 1, 15, and 29.

Further, the Examiner's assertions in the Office Action that Johnson teaches "interfaces with the disparate operating systems" is respectfully traversed. The Examiner relies upon Figure 8, label 804 - 805 of Johnson. However, Figure 8, label 804-805 of Johnson discusses

“transmit query to server” (804) and “match query to patient” (805) without discussing “interfaces with disparate operating systems” as recited in the claims of the present application.

The Examiner’s assertions that Johnson discusses (in the Abstract and throughout) “a plurality of image and text formats” is respectfully traversed. More specifically, Johnson does not appear to discuss or suggest “image” formats, nor does Johnson mention “image”.

Further, the Examiner relies on Johnson, Figure 7, to assert that the master patient record is capable of mapping documents containing therein text and image data stored in a database to patient records. Johnson does not discuss or suggest “image data”, and, moreover, the master patient record of Johnson does not correspond to the “master control file” of the present invention.

The Examiner further relies on Johnson, Figure 7, as discussing that the system is capable of maintaining the database. Claims 1, 15, and 29 recite “a database of text and image data and medical records”, whereas Johnson does not discuss or suggest a database which includes “image data” as in the present invention.

The Examiner relies upon Johnson, Figure 4-6, as discussing receiving and storing the documents, but Johnson does not discuss “retrieving the patient episode data from the secure file and storing the patient episode data in the database” as recited in claims 1, 15, and 29 of the present application.

The Examiner relies upon Johnson, Abstract and throughout, as discussing retrieving the stored documents, wherein the documents are stored in the native formats. However, Johnson does not discuss or suggest “a plurality of image and text formats” as recited in claims 1, 15, and 29 of the present application.

The Examiner relies upon Johnson, Figure 7, Abstract as discussing the master patient record is capable of linking with a plurality of documents in any format, and upon Johnson, Figure 1, as discussing plurality of subscribers. Johnson does not discuss or suggest “a plurality of image and text formats” as recited in claims 1, 15, and 29 of the present application.

The Examiner further asserts that Johnson, Figure 2, providing patient data electronically over a network reads on “patient episode data”. However, Johnson, col. 6, at line 24, in reference to Figure 2, discusses “patient demographic information” rather than “patient episode data” as recited in claims 1, 15, and 29 of the present application.

Further, the Examiner asserts that Johnson teaches that computer security is well known and should be applied to medical information (col. 14, at lines 4-25). Johnson discusses a

“privileges mask” but not “capturing patient episode data into a secure file” as recited in claims 1, 15, and 29 of the present application.

The Examiner asserts that Johnson col. 5, lines 23-25, discusses that e-mail is also known in the art and may be used to communicate medical data, however, Johnson, col. 5, at lines 23-25 discusses “E-Mail services for delivering messages between providers”. Johnson does not discuss “capturing patient episode data into a secure file” and “transmitting the secure file as an e-mail attachment” as recited in claims 1, 15, and 29 of the present application.

The Examiner asserts that Johnson, Figure 2, label 208, teaches receiving the transmitted patient data for storage. However, Johnson, Figure 2, label 208 is a “Report Handler”.

In addition, the Examiner admits that Johnson does not discuss “a secure file, transmitting the secure file as an e-mail attachment, retrieving the patient episode data from the secure file”.

The Examiner takes Official Notice that sending a file encrypted by e-mail is old and well established in the art of network security.

The Examiner’s assertions of Official Notice are respectfully traversed. The Examiner’s assertions of Official Notice are not properly officially noticed and not properly based upon common knowledge. The Examiner is respectfully requested to support the assertion of Official Notice by citing a reference or by affidavit or withdraw same.

More specifically, the Examiner has not provided any reasoning to support the Examiner’s assertions, particularly taking into account the filing date and priority dates of the subject application.

The Examiner’s assertions that “At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of the Official Notice within the embodiment of Johnson and the Official Notice with the motivation of providing an efficient form of file transfer that is easy for physicians to use” are respectfully traversed.

Johnson teaches away from “transmitting a secure file as an e-mail attachment” in that Johnson, col. 14, lines 4-25, discusses “each record contains a field for an E-mail address” and the use of “a privileges mask”. That is, Johnson discusses including the e-mail address into the record rather than attaching the record to an e-mail. Johnson discusses the use of “privilege

level” rather than “transmitting a secure file as an e-mail attachment” as recited in the claims of the present application.

Further, the Examiner’s assertions that the “skilled artisan would have recognized the benefit that since physicians are already familiar with emailing, it would be easier to use email to submit patient data than to train physicians to use a different interface” are respectfully traversed. Johnson, col. 14, lines 4-25, teaches away for the reasons set forth above.

Moreover, the Examiner’s assertions as to whether physicians are “already” familiar with e-mailing and whether “it would be easier to use email to submit patient data” are respectfully traversed. The Examiner is respectfully requested to support these assertions by citing a reference or by affidavit or withdraw same.

Johnson, either alone or in combination with the foregoing assertions of Official Notice by the Examiner, does not discuss or suggest “a master control file controlling and providing interoperability of a medical records system between computer platforms operating on disparate operating systems, the master control file interfacing with a database of text and image data and medical records and with the disparate operating systems, and the computer platforms including a personal computer, a hand-held device, and a network” as recited in independent claims 1, 15, and 29 of the present application.

Claims 1, 15, and 29 of the present application each recites “the computer platforms including a personal computer, a hand-held device, and a network”, which limitation is not discussed or suggested by Johnson. Therefore, it is respectfully submitted that Johnson does not discuss or suggest the foregoing features of the present invention, and does not teach that the Johnson system is capable of communicating with “a personal computer, a hand-held device, and a network” as recited in claims 1, 15, and 29 of the present application.

Regarding claim 2, the Examiner’s assertions that any hand-held device within the scope of claim 1 and capable of communicating with the apparatus “inherently” executes “medical software” to communicate with the claimed apparatus are respectfully traversed. The Examiner is respectfully requested to support the assertion of inherence by citing a reference or by affidavit or withdraw same.

Regarding claim 3, the Examiner asserts that Johnson teaches that the system is capable of accepting documents from a plurality of subscribers (Figure 1) and retrieving

information for the plurality of subscribers (Figure 8). However, Johnson does not discuss or suggest “the master control file provides the medical records system with the interoperability to populate, maintain and retrieve information from its database” as recited in claim 3 of the present application.

Regarding claim 4, the Examiner asserts that Johnson teaches (Figures 3 and 7) that the system is capable of maintaining the database. However, Johnson does not discuss or suggest “the master control file controls path and name of folder images, path to and name of the database, database field names, attributes, and locations on the folder image” as recited in claim 4 of the present application.

The Examiner’s assertions that Examiner considers a database table containing therein the documents to be a “folder” are respectfully traversed. Johnson does not discuss “folder images” as recited in claim 4 of the present application.

Regarding claim 5, the Examiner’s assertions are respectfully traversed. Figure 5 of Johnson represents a document rather than meeting the limitations recited in claim 5 of “each field name is retained and utilized by the medical records system when it populates and retrieves information”.

Regarding claim 7, the Examiner asserts that Johnson (Figure 7 label 706) discusses linking the document identifier to the master patient identifier for display. However, Johnson does not discuss or suggest “a pointer to and name of graphic images indicates the images that display when the medical records system is executed” as recited in claim 7 of the present application.

Regarding claim 9, the Examiner asserts that Johnson teaches that the system is capable of storing medical data (Figure 7). Claim 9 is patentable at least for its dependence upon claims 2 and 1 of the present application.

Regarding claim 10, the Examiner asserts that Johnson teaches that the system is capable of allowing remote subscribers to review patient records (Figure 8). Claim 10 is patentable at least for its dependence upon claims 2 and 1 of the present application.

Regarding claim 11, the Examiner asserts that Johnson discusses that the system is capable of allowing remote subscribers to review patient records (Figure 8). However, Johnson does not discuss “wherein the records system storing patient medical records to enable health care providers to view health indicators remotely” as recited in claim 11 of the present application.

Regarding claim 12, the Examiner asserts that “encryption is a form of ‘compresses’”. Claim 12 of the present application recites “wherein the apparatus captures, compresses, encrypts, and encapsulates patient episode data into the secure file”. That is, claim 12 recites “compresses” and “encrypts”.

The Examiner’s assertions that “encryption is a form of ‘compresses’” are respectfully traversed.

In accordance with MPEP 2144.03,

assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art

The Examiner is respectfully requested to support these assertions by citing a reference or by affidavit, or withdraw same.

Johnson does not discuss or suggest the features recited in claim 12 of “wherein the apparatus captures, compresses, encrypts, and encapsulates patient episode data into the secure file”.

Regarding claim 13, Johnson does not discuss or suggest “wherein the apparatus transmits the secure file to a repository mail server, which de-encapsulates and uncompresses the secure file and stores the de-encapsulated, uncompressed secure file into a patient medical record” as recited in claim 13 of the present application.

Regarding claim 14, the Examiner asserts that Johnson (Figure 4 label 422) teaches database triggers capable of notifying subscribers that new patient data is available for a specific patient of interest. Claim 14 of the present application recites “a message is transmitted to an assigned physician notifying the assigned physician of the receipt of the patient episode data”. Claim 14 is patentable at least for its dependence upon claim 13.

The Examiner asserts that claims 15, 16, 17, 18, 19, 21, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 35, 37, 38, 39, 40, 41, and 42 are rejected for the same rationale applied to the rejections of claims 1, 2, 3, 4, 5, 6, 7, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 21, 23, 24, 25, 26, 27, and 28. However, the Examiner does not assert a rationale for rejecting claims 15, 16, 17, 18, 19, 21, 23, 24, 25, 26, 27, and 28.

Claims 15 and 29 are patentable for a similar rationale as discussed above with respect to claim 1.

Claims 16 and 30 are patentable for a similar rationale as discussed above with respect to claim 2.

Claims 17 and 31 are patentable for a similar rationale as discussed above with respect to claim 3.

Claims 18 and 32 are patentable for a similar rationale as discussed above with respect to claim 4.

Claims 19 and 33 are patentable for a similar rationale as discussed above with respect to claim 2.

Claims 21 and 35 are patentable for a similar rationale as discussed above with respect to claim 7.

Claims 23 and 37 are patentable for a similar rationale as discussed above with respect to claim 9.

Claims 24 and 38 are patentable for a similar rationale as discussed above with respect to claim 10.

Claims 25 and 39 are patentable for a similar rationale as discussed above with respect to claim 11.

Claims 26 and 40 are patentable for a similar rationale as discussed above with respect to claim 12.

Claims 27 and 41 are patentable for a similar rationale as discussed above with respect to claim 13.

Claims 28 and 42 are patentable for a similar rationale as discussed above with respect to claim 14.

Withdrawal of the rejections of claims 1-5, 7, 9-19, 21, 23-33, 35, and 37-42 under 35 U.S.C 103 is respectfully requested.

IV. Rejections of claims 6, 20, and 34 under 35 U.S.C. 103

The Examiner admits that Johnson and the Examiner's assertions of Official Notice do not teach "the pointer to and the name of the database indicates the database" but relies upon Amit (Federated Database Systems for Managing Distributed, Heterogeneous, and Autonomous Databases) as discussing "the pointer to and the name" between databases (Amit, page 192, Section 1.1).

Moreover, the Examiner asserts that "At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Amit within the embodiment of Johnson and the Official Notice with the motivation of providing increased availability, increased reliability, and improved access time (Amit; page 185, column 2 Section Distribution)". Amit, page 185, column 2 Section Distribution, discusses distributed databases whereas Johnson identifies the problem of "centralizing and sharing medical records" (col. 1, lines 51 and 52) and discusses that a "centralized record keeping system receives record documents from one of a plurality of independent service providers" as Johnson's invention (col. 2, at lines 13-15). Thus, combining Amit with Johnson would not achieve the present invention.

Therefore, neither Johnson, the Examiner's assertions of Official Notice, or Amit, either alone or in combination, discusses or suggests "pointer to and the name of the database indicates the database which the medical records system will populate and retrieve information from" of the present invention.

Claims 20 and 34 are patentable for a similar rationale as discussed above with respect to claim 6.

Withdrawal of the rejections of claims 6, 20, and 34 under 35 U.S.C. 103 is respectfully requested.

Response to Arguments

Claim 44 has been cancelled.

The Examiner's assertions of Official Notice continue to be traversed herein above.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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